C. REMARKS

Status of the Claims

Claims 1-4, 6-12, 14-20, and 22-24 are currently pending in the application. Claims 1, 9, and 17 are currently amended.

Amendment to overcome rejection under 35 USC 101

The Office Action rejects claims 17-20 and 22-24 under 35 USC 101 as claims directed to nonstatutory subject matter. [Office Action, p. 2] In particular, as to claim 17, the Office Action notes that paragraph 0028 of the specification of the present invention describes a machine readable medium which includes "transmission media" which includes "coaxial cables, copper wire or fiber optics, [and] acoustic or light waves." [Office Action, p. 2] The Office Action states that "claims drawn to components involving signals encoded with functional descriptive material do not fall within any of the categories of statutory subject matter as set forth in 35 USC 101, and are therefore, ineligible for protection." [Office Action, p. 2]

Regardless of whether the rejection is correct, to clearly limit claim 17 to statutory subject matter, Applicants amend the preamble of claim 17 to limit the recording medium in claim 17 to a voltile or non-volatile recording medium. Paragraph 0028 of the specification of the present invention distinguishes volatile and non-volatile media from transmission media. Examples of volatile media and non-volatile media are limited to tangible embodiments (e.g. floppy disks and RAM). Therefore, in view of Applicants' amendment of claim 17 to limit claim 17 to a volatile and non-volatile recording medium, Applicants respectfully assert that claim 17 and claims 18-20 and 22-24, which are dependent upon claim 17, are drawn to a tangible recording medium, falling within the categories of statutory subject matter, and therefore the claims should be allowed.

Amendment to overcome rejection under 35 USC 103(a)

The Office Action rejects claims 1-4, 7-12, 15-20, and 23-24 as being obvious under 35 USC 103(a) under Hursey et al. (US Publication 2003/0023875)(referred to herein as Hursey) in view of Smithson et al. (US Patent 6,898,715)(referred to herein as Smithson). [Office Action, p. 2] Regardless of whether the rejection is correct, Applicants amend claims 1, 9, and 17 and traverse the rejection in view of the amendments to the claims.

First, with regard to claims 1, 9, and 17, claim 1, which is representative in limitation and rejection of claims 9 and 17, currently reads:

1.   (Currently Amended) A method for mitigating self-propagating electronic mail viruses, comprising:
    receiving a request to send an electronic mail message with a file attachment to <u>a plurality of</u> at least one intended recipient<u>s</u>;
    <u>calculating at least one number of said plurality of intended recipients assigned to at least one group identifier in an address book storing each of said plurality of intended recipients in association with at least one of a plurality of separate group identifiers;</u>
    retrieving a maximum recipient limit specified for a particular extension type of file attachment from among a plurality of extension types of file attachments <u>and specified for at least one group identifier from among said plurality of separate group identifiers</u>, wherein an extension type of said file attachment matches said particular extension type of said file attachment;
    comparing <u>said at least one number of said plurality of recipients assigned to at least one group identifier in said address book</u> [[a characteristic of said at least one intended recipient with said maximum recipient limit; and
    responsive to said <u>at least one number of said plurality of recipients assigned to at least one group identifier in said address book</u> characteristic of said at least one intended recipient exceeding said maximum recipient limit <u>for said at least one group identifier</u>, requesting a sender authorization prior to sending said electronic mail message, such that if a virus is attempting to self-propagate by sending said electronic mail message said attempt is mitigated.

Applicants note that claims 1, 9, and 17 are amended to include an elements of <u>calculating at least one number of said plurality of intended recipients assigned to at least one group identifier in an address book storing each of said plurality of intended</u>

recipients in association with at least one of a plurality of separate group identifiers, retrieving a maximum recipient limit specified for a particular extension type of file attachment from among a plurality of extension types of file attachments and specified for at least one group identifier from among said plurality of separate group identifiers, comparing said at least one number of said plurality of recipients assigned to at least one group identifier in said address book with said maximum recipient limit, and responsive to said at least one number of said plurality of recipients assigned to at least one group identifier in said address book exceeding said maximum recipient limit for said at least one group identifier. The specification of the present invention teaches the amended limitation of an address book with the intended recipients stored in association with a group identifier, for example, in Figure 4 and paragraph 0045. The specification of the present invention teaches the amended limitation of calculating the number of recipients that fall within a particular address book grouping, retrieving the maximum recipient limit for a particular extension and particular group identifier, and controlling an authorization requirement if the number of recipients of a particular group identifier exceeds the maximum recipient limit for the group identifier for example, in Figure 6 and paragraphs 0047, 0051, 0056, 0058. Because the specification supports the amended element, no new matter is added through the amendment to the claims.

In addition, Applicants respectfully assert that Hursey and Smithson, separately or in combination, do not teach or suggest each and every element of claim 1, and therefore prima facie obviousness is not established in claim 1. In establishing a prima facie case of obviousness under 103(a), the combined prior art references must teach or suggest all the claim limitations. *In re Vaeck*, 947 F.3d 488, 20 USPQ2d 1438 (Fed Cir. 1991). Applicants respectfully assert that a prima facie case of obviousness is not established because Hursey and Smithson, separately or in combination, do not teach calculating at least one number of said plurality of intended recipients assigned to at least one group identifier in an address book storing each of said plurality of intended recipients in association with at least one of a plurality of separate group identifiers or retrieving a maximum recipient limit specified for a particular extension type of file

attachment from among a plurality of extension types of file attachments and specified for at least one group identifier from among said plurality of separate group identifiers, wherein an extension type of said file attachment matches said particular extension type of said file attachment.

Hursey describes determining the percentage of the total address book addresses which are being addressed by the new e-mail message and comparing the percentage of the total address book addresses with a threshold value. *Hursey*, paragraph 0033. No portion of Hursey teaches or suggests an address book with group identifiers associated with addresses.

Smithson describes that a user may set threshold levels and that the system then measures parameters to determine if a threshold level is exceeded. *Smithson*, col. 4, lines 24-44. Smithson provides examples of measurement parameters in col. 4, lines 45-57, such as "how many e-mail messages are sent having a file attachment of a given file type within a predetermined period." None of the measure parameter or threshold examples in Smithson teach, and more particularly, none of the examples suggest, a threshold level that is specified for an attachment type *and* for an address book group identifier.

Therefore, Applicants respectfully assert that neither of Hursey or Smithson, separately or in combination, teaches calculating a number of intended recipients assigned to a particular group identifier and retrieving a maximum recipient limit specified for an attachment type and group identifier. Because Hursey and Smithson, separately or in combination, do not teach each and every element of calculating at least one number of said plurality of intended recipients assigned to at least one group identifier in an address book storing each of said plurality of intended recipients in association with at least one of a plurality of separate group identifiers or retrieving a maximum recipient limit specified for a particular extension type of file attachment from among a plurality of extension types of file attachments and specified for at least one group identifier from among said plurality of separate group identifiers, wherein an extension type of said file attachment matches said particular extension type of said file

attachment, a prima facie case of obviousness is not established for claims 1, 9, and 17, and the claims should be allowed.

Claims 2-4, 6-8, 10-12, 14-16, 18-20, and 22-24

Because claims 1, 9, and 17 are not obvious under Hursey in view of Smithson, at least by virtue of their dependency on claims 1, 9, and 17, dependent claims 2-4, 6-8, 10-12, 14-16, 18-20, and 22-24 are not obvious under 35 U.S.C. §103(a). Because a prima facie case of obviousness is not established for claims 2-4, 6-8, 10-12, 14-16, 18-20, and 22-24, Applicants respectfully request allowance of claims 2-4, 6-8, 10-12, 14-16, 18-20, and 22-24.

Conclusion

In view of the foregoing, withdrawal of the rejections and the allowance of the current pending claims is respectfully requested. If the Examiner feels that the pending claims could be allowed with minor changes, the Examiner is invited to telephone the undersigned to discuss an Examiner's Amendment.

Respectfully submitted,

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